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JUL 17 2006

Atty. Docket No. 408392

REMARKS

Claims 1-11 and 28-34 remain pending in the instant application. Claims 12-27 and 35 are cancelled. Claims 1-8, 11 and 28-34 stand rejected; claims 9 and 10 are allowed. Claim 1 is amended to change the spelling of one word. We believe that the above amendments and the remarks laid out herein below address and overcome each of the Examiner's rejections and objections. Unless otherwise indicated, numbered headings used below reflect the order of issues presented in the final Office Action mailed 17 May 2006.

1-2. Claim Rejections – 35 U.S.C. § 112

Claims 1-8, 11 and 28-34 stand rejected as failing to comply with the written description requirement. In particular, the Examiner states that the phrase "homogeneous composition" in claims 1 and 28 is not supported by the specification, as originally filed, because of lack of any definition therefor in the specification. The Examiner further states that it is unclear what is meant by the phrase.

In response to the latter statement, a homogeneous material is uniform in structure or composition throughout. *The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company*. "Consistent" and "uniform" are exemplary synonyms of "homogeneous". This term is also, and perhaps more commonly, spelled homogenous (without the second *e*). We have therefore amended claim 1 to change the spelling of "homogeneous" to "homogenous", in hopes of clearing up the confusion surrounding the term. Previously presented claim 28 already includes the latter spelling.

As to the purported lack of support in the specification, we again respectfully direct the Examiner to FIGs. 5-13, which show a homogenous (e.g., or consistent or uniform) tape body 101, and we remind the Examiner that "...information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." MPEP § 2163.06. We submit that the pictorial information provided in FIGs. 5-13 supports Applicant's possession of a homogenous tape body. Regarding

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possession, in describing the guidelines for the examination of patent applications under the 35 U.S.C. § 112, para. 1, "Written Description" Requirement, it is clearly stated that:

"An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, *figures, diagrams*, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997)." MPEP § 2163(I), emphasis added.

In order to provide consistency between the written description and the claims, the specification is amended herewith to also include the term "homogenous". We submit that the amendment to the specification is permissible under 35 U.S.C. § 112, at least because a homogenous tape body is shown in the drawings. However, in addition, it is stated that "The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter." MPEP 2163.07. The term "homogenous" was known at the time of filing the '943 Application.

For at least the reasons provided above, we submit that the addition of "homogenous" to both the specification and the claims is permissible under 35 U.S.C. § 112. Accordingly, we respectfully request withdrawal of the Examiner's rejection.

3. Rejection Withdrawn

We thank the Examiner for indicating withdrawal of 35 U.S.C. 102 rejection of claims 1-3, 5, 12 and 14, over Wilson. We agree that Wilson does not anticipate these (or any other) pending claims.

4-6. Rejection Maintained and Response to Arguments

Because the maintained rejections and the Examiner's Response to Arguments deal with the same or similar subject matter, these sections of the pending Office Action are discussed together.

The Examiner maintains the previous rejection of claims 1-5, 7-8, 11, 28-32 and 34 under 35 U.S.C. § 102(e), and claims 6, 15 and 33 under U.S.C. § 103(a), discussed in detail below.

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The Examiner also states that Applicant's arguments of 24 February 2006 have been considered, but are not persuasive. In further explanation, the Examiner notes that Applicant has argued that Bastiaens fails to teach a homogeneous tape body, and states that the phrase "homogeneous composition" is considered to be new matter. Next, the Examiner states that layers 34 or 30 of Bastiaens figure 2 are found to be homogeneous, and that "contrary to applicant's allegation, the presence of additional material is not precluded from the tape body." Office Action p. 3, final paragraph.

Claim Rejections – 35 U.S.C. § 102

Claims 1-5, 7-8, 11, 28-32 and 34 remain rejected under 35 U.S.C. § 102(e) as being anticipated by Bastiaens, for reasons given in the last Office Action. In the last Office Action, the Examiner continued to insist that Bastiaens teaches a tape with a front face comprising at least one symbol. See, e.g., the last Office Action, p. 6, item number 11. However, regardless of this, Bastiaens fails to show the identical invention as contained in amended claims 1-5, 7-8, 11, 28-32 and 34, and therefore cannot and does not anticipate said claims.

Independent Claims 1 and 28: Independent claims 1 and 28, as amended, require a pavement tape having a continuous elongated flexible tape body of homogenous composition, including a front face with a symbol printed thereon. As noted above with respect to the Examiner's 35 U.S.C. § 112 rejection, these amendments are fully supported by the '943 Application as filed.

Bastiaens' retroreflective article does not include a homogeneous tape body. Rather, Bastiaens clearly describes and depicts "the surface of the base material comprises a binder layer of polyvinyl butyral resin *having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin.*" Bastiaens col. 1, lines 51-55, emphasis added; FIGs. 2 and 4. This mixed binder layer of the surface is not homogenous, because it is not consistent in composition (e.g., having glass microspheres suspended throughout the binder layer). If Bastiaens' surface is not homogeneous, then neither is her receptor sheet 18, which the Examiner likens to Applicant's tape body. See page 5 of the

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last Office Action, first paragraph. Note in particular that microspheres 32, binder layer 30 and specular layer 34 are shown as components of receptor sheet 18. See Bastiaens' FIGs. 2, 4.

In the Response to Arguments section of the pending Office Action, the Examiner states that Applicant's argument that Bastiaens does not teach a homogenous tape body are not persuasive, "because, as shown in figure-2 of Bastiaens, the layers 34 or 30 are found to be homogenous." Pending Office Action, "Response to Arguments", second paragraph. Respectfully, the Examiner's argument does not make sense.

First, layer 30 is not homogenous. For example, if vertical slices were made through layer 30, some slices would contain portions of glass microspheres 32, and some slices would not contain any glass beads. The slices would not be consistent.

Second, the Examiner has already equated Bastiaens' receptor sheet 18 with Applicant's tape body 101. See page 5 of the last Office Action, first paragraph. As shown in Bastiaens' FIG. 2, layers 30, 34, 36 and 37 are all parts of receptor sheet 18. If receptor sheet 18 includes a non-homogenous layer, then the receptor sheet itself cannot be homogeneous. For example, vertical cross sections through receptor sheet 18 would not be consistent, because some would have portions of glass microspheres included in binder layer 30, and some would not. Bastiaens' receptor sheet 18 fails to anticipate Applicant's tape body 101, because it is clearly not homogenous. Compare receptor sheet 18 in Bastiaens FIGs. 2 and 4 with Applicant's tape body 101, in FIGs. 5-13.

On the other hand, Applicant's claims clearly recite a continuous elongated flexible tape body of homogenous composition. As shown above, the addition of the term "homogenous composition" is in compliance with 35 U.S.C. § 112.

Regarding the Examiner's statement that "contrary to applicant's allegation, the presence of additional material is not precluded from the tape body," Office Action p. 3, final paragraph, we note that Applicant's claims 1 and 28 do not include the limitation of additional material in the tape body. Respectfully, the Examiner appears to be reading additional limitations into the

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claims, and then using these additional (and non-recited) limitations to reject the claims. The Examiner must examine the claims as presented.

We remind the Examiner that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Bastiaens does not teach each and every claim element, and therefore cannot anticipate claims 1 and 28. We believe that claims 1 and 28 are patentable over Bastiaens at least because Bastiaens does not teach, depict or suggest a homogeneous tape body. However, contrary to the Examiner's prior arguments, Bastiaens also fails to teach or suggest a symbol that is printed upon a front face, as is also required in claims 1 and 28.

The Examiner maintains that the front face of Bastiaens' retroreflective article "is provided with information print". Last Office Action p. 5, line 6. Respectfully, we must again note that an article provided with information print is not the same as a tape with a front face having at least one symbol printed upon said front face. As we have presented before, Bastiaens does not print a symbol upon a front face of her retroreflective article. Instead, Bastiaens prints a symbol on a transfer sheet (7). The symbol is then transferred to, not printed upon the retroreflective article. As we have noted, Bastiaens' transfer sheet 7 is not a part of Bastiaens' final product. Rather, it is used in making Bastiaens' base construction, which is then used to make retroreflective articles. See for example Bastiaens' FIG. 3, showing an image 24 being transferred from an image transfer sheet (represented by web 28, see Bastiaens col. 3, line 9) to the surface 33 of binder layer 30 of a receptor sheet. As shown in Bastiaens' FIG. 3, once the image is transferred, the transfer sheet is collected on pickup roll 36, and the imaged receptor sheet web (which is then used to make retroreflective articles - the "final products") is collected on a separate pickup roll 34. See Bastiaens col. 3, lines 7-22.

We again remind the Examiner that to anticipate a claim, Bastiaens must teach every element of the claim and "the *identical invention* must be shown in as complete detail as contained in the ... claim." MPEP 2131, citing *Verdegaal Bros. V. Union Oil Co. of California*,

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814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989), emphasis added. However, Bastiaens does not teach a front face of a pavement tape with a symbol printed thereon. Rather, Bastiaens repeatedly and clearly describes and depicts printing an image on a transfer paper, and then transferring the image to a receptor sheet. See, e.g., Bastiaens col. 1, lines 47-51; col. 2, lines 62-67; FIG. 3. An article with an image transferred upon it (as in Bastiaens) is not identical to an article (or a tape, in Applicant's case) with a symbol printed upon it. Therefore, there can be no anticipation.

We have shown that Bastiaens teaches neither a homogenous tape body, nor a symbol printed on a front face of a tape body. We therefore request withdrawal of the Examiner's rejection, and allowance of independent claims 1 and 28.

Dependent Claims 2-5, 7-8, 29-32 and 34: Claims 2-5, 7-8 and 11 depend from claim 1. Claims 29-32 and 34 depend from claim 28. The aforementioned dependent claims thus benefit the arguments presented in support of claims 1 and 28. However, there are additional reasons for the patentability of claims 2-5, 7-8, 11, 13-14, 16-17, 19, 29-32 and 34, including the following:

Claims 2, 3 and 29, 30: Bastiaens does not teach the limitations of these claims, in the context of respective base claims 1 and 28.

Claims 4 and 31: The Examiner continues to reject these claims, taking the stance that Bastiaens' transfer sheet 7 anticipates Applicant's flexible protective tape, one face of which is releasably bonded to the front face of Applicant's pavement tape. In support of this stance, the Examiner points to Bastiaens' FIG. 2, stating that "as clearly seen in figure-21 of Bastiaens, the layer (7) is a tape that protects the image and the top surface until it is removed therefrom." Pending Office Action p. 4, lines 7-8. However, Bastiaens' transfer sheet 7 is not a tape, and Bastiaens nowhere teaches or suggests that it serves a protective function.

First, Bastiaens clearly states that "the image transfer sheet 7 comprises a *paper* support base 3." Bastiaens col. 2, line 42-43. Next, as is well known in the art of image transfer, a transfer sheet holds an image which is then transferred to a separate substrate. It is typically

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utilized only for the purpose of transferring the image, after which it is thrown away or recycled. Accordingly, Bastiaens nowhere describes it as a tape, and Bastiaens specifically teaches that the transfer sheet (7) is used in making the retroreflective article, but it is not a part of the finished product:

"The printer 100 uses electrostatic means to form and develop a latent electrostatic image on an image transfer sheet 7 which may be a single sheet or a continuous web. The image transfer sheet 7 comprises a paper support base 3 having first a conductive layer 2 and then a dielectric layer 4. A release coating 6 may be applied to the dielectric layer 4 to facilitate transfer of an image. The surface of the image transfer sheet 7 having the release coating 6 proceeds in a direction 8 first passing a stylus writing head 10 which deposits a charge 12 having varying charge density to define a latent electrostatic image. After passing the writing head 10, the image transfer sheet 7 passes a toning station comprising a toner applicator 16 in contact with a liquid toner bath 18 in a container 20. The liquid toner comprises toner particles dispersed in an insulating liquid and are collectively referred to as the liquid toner bath 18. Liquid toner 22 is transported by the applicator 16 to the image transfer sheet 7 and deposited to form a toned image 24 conforming to the latent electrostatic image 12." Bastiaens col. 2, lines 38-57; FIG. 1. Furthermore, "The image transfer sheet web 28 and the receptor sheet web 38 pass through the nip 40 of rollers 42, 44 where heat and pressure are applied *to transfer the toned image 24 from the image transfer sheet web 28 to the surface 33 of binder layer 30 of the receptor sheet web 38.* The continuous webs 28, 38 are collected by pickup rolls 36, 34. *The imaged receptor sheet provides a base construction suitable for making retroreflective articles.*" Bastiaens col. 3, lines 15-22, emphasis added.

Bastiaens' FIG. 3 illustrates the image transfer sheet web being collected on a pickup roll after transfer of the toned image. As is clearly shown and described, the imaged receptor sheet web 34 is collected on a different pickup roll than the receptor sheet web 38, which is then "suitable for making retroreflective articles." The transfer sheet is plainly not a part of the base construction that is used to make Bastiaens' retroreflective articles.

In image transfer of the type practiced in Bastiaens, the transfer sheet does not include any adhesive (in other words, it is not a tape). Indeed, Bastiaens recites "the image transfer sheet 7 comprises a *paper* support base 3." Bastiaens col. 2, line 42-43. There is no mention of a tape or any adhesive involved with transfer sheet 7. Accordingly, Bastiaens lists Trident Transfer Paper ES as a suitable transfer sheet. We direct the Examiner's attention to the

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previously-submitted 3M Product Bulletin describing Trident Transfer Paper. There is no mention of any adhesive property anywhere within the Product Bulletin, notably because common sense teaches against using a tape or even an adhesive paper as the transfer sheet in Bastiaens. If Bastiaens were to use a sticky transfer paper or a tape, it would likely stick to itself when wound on roll 20, making it difficult to cleanly pass the transfer sheet web through Bastiaens' image transfer station 300. See Bastiaens FIG. 3

Furthermore, Bastiaens nowhere describes transfer sheet 7 as having a protective function. Rather, Bastiaens repeatedly teaches that transfer sheet 7 is used to transfer an image to a receptor sheet, for example when the two are pressed together by rollers. Bastiaens clearly and explicitly states that "FIG. 2 illustrates in cross section an image transfer sheet 7 having a toned electrostatic image 24 in juxtaposition to a receptor sheet 18 comprising base material *in preparation for transferring the image 24 to the surface 33 of the receptor sheet 18.*"

Bastiaens col. 2, lines 63-67, emphasis added; see also col. 3, lines 7-22.

Respectfully, Bastiaens' transfer sheet does not provide sufficient basis for an anticipation rejection. Transfer sheet 7 is not a tape, it is not bonded to Bastiaens' base construction, and Bastiaens nowhere indicates that it has any protective function.

Absent any such express teaching, and since, per MPEP § 2131, a claim is only anticipated if every element is found, either expressly or inherently, it appears that the Examiner must be making an inherency argument. We must therefore point out the inappropriateness of the Examiner's comment that "Applicant has failed to show that the presence of the layer (7) does not provide protection to the top surface of Bastiaens' tape" (Pending Office Action p. 4, lines 9-10). In cases of inherency, the burden of proof lies with the Examiner, not with Applicant. MPEP § 2112 states:

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2D 1461, 1464 (Bd. Pat. App. & Inter. 1990)."

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The Examiner has not provided any basis in fact or technical reasoning to support the allegation that transfer sheet 7 is a tape, or that transfer sheet 7 has a protective function. We contend that such factual support or technical reasoning cannot be found, especially in light of Bastiaens' specific teaching that transfer sheet 7 is paper and that transfer sheet 7 is used to transfer an image to a receptor sheet. In addition, logic teaches away from transfer sheet 7 having adhesive properties at all, as noted herein above. The Examiner's rejection of claims 4 and 31 therefore fails.

Claims 5-8 and 32-34: The Examiner states that Applicant's prior argument (that Bastiaens' does not teach an at least partially reflective symbol) does not make sense, because applicant merely contends but fails to show how the claimed partially reflective symbol is different. We attempt to clarify:

Bastiaens recites a retroreflective article with an image on the surface of a retroreflective base material, wherein "the surface of the base material comprises a binder layer of polyvinyl butyral resin having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin." col. 1, lines 53-55; see also FIG. 2 and col. 2, line 63 - col. 3, line 4. "The receptor sheet is a base material comprising glass microspheres that provide a low level of retroreflectivity. The glass microspheres are dispersed throughout the binder layer and are present substantially as a monolayer dispersed in the binder layer with an underlying specular reflective layer spaced from the microspheres by the transparent binder material." Bastiaens col. 4, lines 4-10. An image is transferred to this base material, in particular, "to the side of the base material closest to the microspheres and opposite the reflective layer." Bastiaens col. 4, lines 34-35. In other words, the base material, and not the symbol itself, appear to be reflective.

On the other hand, claims 5-8 and 32-34 clearly recite that at least part of the symbol itself is reflective. Again, Bastiaens does not describe the image itself as reflective or partially reflective, but describes a reflective specular layer below. Again, absent such express teaching by Bastiaens, the Examiner appears to be making an argument that an at least partially reflective image is inherent in Bastiaens. However, the Examiner has not provided any basis in fact, or any

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technical reasoning, to support the opinion that Bastiaens' image is at least partially reflective. The rejection of claims 5-8 and 32-34 therefore fails.

Claim 11: The Examiner argues that Applicant has failed to show how the railing is a part of the claimed tape, further stating that in absence of such showing the railing is considered to be "not a positive limitation". We strongly disagree, and we respectfully request that the Examiner review the use of transitional phrases in claims. Claim 11 recites "The pavement tape of claim 1 further comprising at least one railing..." As noted in MPEP § 2111.03, "The transitional term "comprising"...is synonymous with "including," "containing," or "characterized by". "The transitional term "comprising" (and other comparable terms, o.g., "containing," and "including") is "open-ended"- *it covers the expressly recited subject matter*, alone or in combination with unrecited subject matter." MPEP § 2163(II)(a)(1), emphasis added. In other words, "Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim. MPEP § 2111.03, quoting *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

As supported by the above teachings, claim 11 covers a pavement tape including the expressly recited at least one protective railing. Bastiaens is completely silent as to any railing; therefore claim 11 is not anticipated.

We have demonstrated that Bastiaens does not anticipate claims 1-5, 7-8, 28-32 and 34. Withdrawal of the Examiner's rejection under 35 U.S.C. § 102(e), and allowance of all pending claims, is therefore respectfully requested.

Claim Rejections – 35 U.S.C. § 103

The Examiner rejects claims 6, 15 and 33 in the Pending Office Action as being unpatentable in view of Bastiaens. However, claim 15 has long been cancelled from the '943 Application.

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Regarding pending claims 6 and 33, regardless of whether or not the specific dimensions of Applicant's pavement tape would have been obvious, claims 6 and 33 depend, respectively, from claims 1 and 28. Bastiaens does not render base claims 1 or 28 *prima facie* obvious. Courts have ruled that if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071.5 USPQ2d 1596 (Fed. Cir. 1988). Thus, claims 6 and 33 are allowable over Bastiaens, at least because they depend (respectively) from claims 1 and 28. Withdrawal of the Examiner's rejection is respectfully requested, as is allowance of claims 6 and 33.

7. Allowable Subject Matter

We thank the Examiner for indicating that claims 9 and 10 are allowed. However, we contend that all pending claims are allowable over the cited art. We respectfully request withdrawal of the Examiner's rejections, and allowance of claims 1-8, 11 and 28-34.

13. Conclusion

We have shown that the cited Bastiaens patent neither anticipates claims 1-5, 7-8, 28-32 and 34, nor establishes a *prima facie* case of obviousness over claims 6 and 33. Bastiaens thus fails under 35 U.S.C. §§ 102, 103. We respectfully request withdrawal of each of the Examiner's rejections, and we solicit a Notice of Allowance for all of claims 1-11 and 28-34.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment.

We again specifically request to interview this case should any issues remain outstanding. The Examiner is therefore encouraged to telephone the undersigned attorney should this occur and prior to any Advisory Action.

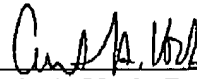
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This Rule 116 Amendment and Response is submitted within 3 months of the 17 May 2006 Office Action. Therefore, no fees are believed due. However, if any fee is deemed necessary in connection with this Rule 116 Amendment and Response, the Commissioner is hereby authorized to the aforementioned deposit account.

Respectfully submitted,

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